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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,637	03/21/2001	Anthonie Cornelis de Visser	VER-142XX	3042
207	7590	01/16/2004	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			SHEWAREGED, BETELHEM	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,637

Applicant(s)

DE VISSER ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwabara et al. (EP 0 649 753 A1).

Kuwabara discloses an ink transfer medium having a base material (col. 11, line 12) and a transfer portion comprising a liquid reactive resin layer that exhibits permeability (col. 4, line 10). The liquid reactive resin layer may be made of water-soluble resin such as gelatin, carboxymethylcellulose and polyvinyl alcohol (col. 13, line 1). With respect to porosity value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Kuwabara reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Kuwabara does not disclose the ink receiving layer is being applied on to a certain side, i.e., wire side of the paper base. It is known that the wire side of a paper is

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smoother, and it is also known that applying a coating composition onto a smoother surface improves surface contact between the paper and the coated layer. Therefore, at the time of the invention, a person of ordinary skill in the art would have been motivated to select the smoother side of a paper in order to increase surface contact.

With respect to claims 7 and 8, the amount of filler in the release or barrier layer can be up to 15%, which also includes 0% filler or no filler in the layer. When the amount of filler is 0%, the claimed invention reads on Kuwabara.

With respect to claim 11, since the transfer medium of Kuwabara is substantially identical to the claimed invention, the transfer medium of Kuwabara would have a photo quality as the claimed article.

With respect to claims 9 and 19, Kuwabara does not disclose a non-transferable dye in the liquid reactive resin layer. However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the dye in the layer to change the color of the layer as desired.

3. Claims 1-4, 7, 9-12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (US 5,672,413).

Taylor discloses a transfer an ink jet transfer system comprising a temporary carrier sheet, a protective layer on the carrier sheet and an image receptive adhesive layer on the protective layer (abstract). The adhesive layer is equivalent to the claimed release or barrier layer. The adhesive layer comprises polymeric resins and 0-10% spacer particles (col. 4, lines 5-9). The adhesive layer accepts hot melt ink (col. 3, line

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59). With respect to porosity value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Taylor reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Taylor does not disclose the ink receiving layer is being applied on to a certain side, i.e., wire side of the paper base. It is known that the wire side of a paper is smoother, and it is also known that applying a coating composition onto a smoother surface improves surface contact between the paper and the coated layer. Therefore, at the time of the invention, a person of ordinary skill in the art would have been motivated to select the smoother side of a paper in order to increase surface contact.

With respect to claim 11, since the transfer system of Taylor is substantially identical to the claimed invention, the transfer system of would have a photo quality as the claimed article.

With respect to claims 9 and 19, Taylor does not disclose a non-transferable dye in the liquid reactive resin layer. However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the dye in the layer to change the color of the layer as desired.

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Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

A handwritten signature in black ink, appearing to be 'B. Shewareged', with a stylized flourish at the end.

Betelhem Shewareged
January 09, 2004.